UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/567,534	08/17/2006	Daniel Deakter		8587

7590   10/13/2010

Daniel R. Deakter
8281 Hampton Wood Drive
Boca Raton, FL 33433

EXAMINER
PORTER, RACHEL L

ART UNIT	PAPER NUMBER
3626	

MAIL DATE	DELIVERY MODE
10/13/2010	PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

	Application No.	Applicant(s)
Office Action Summary	10/567,534	DEAKTER, DANIEL
	Examiner	Art Unit
	RACHEL L. PORTER	3626

-- *The MAILING DATE of this communication appears on the cover sheet with the correspondence address* --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE <u>3</u> MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.
- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on <u>09 July 2010</u>.

2a)☒ This action is FINAL.   2b)☐ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) <u>1-10</u> is/are pending in the application.

     4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) <u>1-10</u> is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

     Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

     Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

     a)☐ All   b)☐ Some * c)☐ None of:

       1.☐ Certified copies of the priority documents have been received.

       2.☐ Certified copies of the priority documents have been received in Application No. _____.

       3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

     * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1)☒ Notice of References Cited (PTO-892)

2)☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)

3)☐ Information Disclosure Statement(s) (PTO/SB/08) Paper No(s)/Mail Date _____.

4)☐ Interview Summary (PTO-413) Paper No(s)/Mail Date _____.

5)☐ Notice of Informal Patent Application

6)☐ Other: _____.

DETAILED ACTION

1.   This communication is in response to the amendment filed 7/9/10. Claims 1-10

are pending.

Claim Rejections - 35 USC § 101.

2.   The rejection of Claims 8-10 under 35 U.S.C. 101, is hereby withdrawn due to

the amendment filed 7/9/10.

Claim Rejections - 35 USC § 112

3.   The following is a quotation of the second paragraph of 35 U.S.C. 112:

> The specification shall conclude with one or more claims particularly pointing out and distinctly
> claiming the subject matter which the applicant regards as his invention.

4.   Claims 4-5 are rejected under 35 U.S.C. 112, second paragraph, as being

indefinite for failing to particularly point out and distinctly claim the subject matter which

applicant regards as the invention.

Claim 4 recites the "processor is programmed with a rule-based system to vary

search parameter priority, based on the type of data requested, wherein said search

parameter priority is set to search free text keywords or a phrase in a specified order."

Claim 5 further recites that "said search parameter is set to perform text analysis last."

The Examiner understands all search/query processing to require the

use/performance of "text analysis," in some form. Therefore it is unclear to the

Examiner what action(s) are being performed in claim 5, and how the search parameter

priority for a "text analysis" can be performed last.

For the purpose of applying art, the examiner will interpret limitation to mean that

a text analysis is performed.

Claim Rejections - 35 USC § 102

5.   The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that

form the basis for the rejections under this section made in this Office action:

> A person shall be entitled to a patent unless –
>
> (e) the invention was described in (1) an application for patent, published under section 122(b), by
> another filed in the United States before the invention by the applicant for patent or (2) a patent
> granted on an application for patent by another filed in the United States before the invention by the
> applicant for patent, except that an international application filed under the treaty defined in section
> 351(a) shall have the effects for purposes of this subsection of an application filed in the United States
> only if the international application designated the United States and was published under Article 21(2)
> of such treaty in the English language.

6.   Claims 1-3, and 6-10 are rejected under 35 U.S.C. 102(e) as being anticipated by

Rao et al US 20030130871 A1 (which incorporates by reference in its entirety US

2003/0120458A1, also by Rao et al.--portions from this application are cited in the

rejection below as mentioned)

[claim 1]   Rao discloses a system for automatically matching patients to clinical trials

comprising:

- a database component operative to maintain: one or more hospital patient

   database components and their one or more hospital databases and their

   corresponding plurality of patient names and their medical records, (Figures 2-3-

   (250 or 350) collects info. from hospitals); par. 17, 31) wherein said hospital

patient database components are in communication with one or more medical

practice database components and their corresponding plurality of specialties

and their corresponding plurality of patient names and their medical records;

(par. 17, 31, par 51—the Database/repository which receives hospital record

data serves as a place where drug companies can go and requests list of people

fitting desired criteria; system may also track physician for patients meeting

particular criteria)

- a clinical studies database component and its corresponding plurality of clinical

  studies; (Figure 3, (390) studies database)

- a communications component to receive changes to said database component;

  and (par. 28-29 network interface; external storage using a database

  management system managed by the processor)

- a processor programmed to: periodically match compatible patients and clinical

  studies and generate reports to matched medical practices in said medical

  practice database component having one or more patients matched to at least

  one clinical study. (par. 35 and 48-51)

[claim 2]   Rao discloses the system according to claim 1, wherein: said database

component identifies patient names associated with each medical practice in said

medical practice database component; (par. 31, 34,-35) and said processor generates

reports to medical practices having identified patients, said reports including a listing of

prospective patients for at least one clinical trial. (par. 36)

[claim 3] Rao discloses the system according to claim 1, further comprising: a searching component for searching said clinical studies database component, and said one or more hospital patient database components, wherein said communications component is adaptable to receive searching order instructions. (par. 51—clinical trials brokerage component can access CPR with patient hospital records; and can also have contact with patients seeking a particular study)

[claim 6]   Rao disclose the system according to claim 1 wherein said processor is further programmed to convert database information from incompatible operating systems to the operating system of the processor. (par. 37--through incorporation by reference of "Patient data Mining," US 2003/01308 par. 44—Rao explains the generation of the CPR. The data sources include structured and unstructured information. Structured information may be converted into standardized units, where appropriate. Unstructured information may include ASCII text strings, image information in DICOM (Digital Imaging and Communication in Medicine) format, and text documents partitioned based on domain knowledge.)

[claim 7]   Rao teaches the system according to claim 1, wherein said clinical studies database contains clinical trials selected from the group consisting of clinical drug trials and clinical device trials. (Figures 2-3; par. 31,50—clinical drug studies)

[claim 8]   Rao discloses a computerized method for matching patients to clinical

medical studies comprising:

- identifying a group of patients in a hospital database; (par. 36, 39)

- identifying at least one clinical study;(par. 50)

- maintaining a database identifying each said patient in said hospital database

  and each said clinical study; and (par. 51)

- comparing said group of patients in said hospital database to said clinical studies

  and matching one or more patients in a hospital database to one or more clinical

  trials(Figure 4; par. 51-52), utilizing a computer to perform said comparison.

  (par. 25-28, 31—system operations performed by a computer)

[claim 9]   Rao discloses the method according to claim 8, further comprising:

maintaining said database to include a plurality of patient profiles associated with a

corresponding medical practice;(par. 34-35) and notifying a medical practice when at

least one of said patient profiles matches the requirements of said clinical studies. (par.

35)

[claim 10]   Rao discloses the method according to claim 8, wherein said step of

maintaining a database further comprises converting data from an incompatible

operating system to the operating system of the processor. (par. 37--through

incorporation by reference of "Patient data Mining," US 2003/01308 par. 44—Rao

explains the generation of the CPR. The data sources include structured and

unstructured information. Structured information may be converted into standardized

units, where appropriate. Unstructured information may include ASCII text strings,

image information in DICOM (Digital Imaging and Communication in Medicine) format,

and text documents partitioned based on domain knowledge.)

Claim Rejections - 35 USC § 103

7.   The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all

obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set
> forth in section 102 of this title, if the differences between the subject matter sought to be patented and
> the prior art are such that the subject matter as a whole would have been obvious at the time the
> invention was made to a person having ordinary skill in the art to which said subject matter pertains.
> Patentability shall not be negatived by the manner in which the invention was made.

8.   Claims 4-5 are rejected under 35 U.S.C. 103(a) as being unpatentable over Rao

et al US 20030130871 A1 (which incorporates by reference in its entirety US

2003/0120458A1, also by Rao et al.--portions from this application are cited in the

rejection below as mentioned) in view of Ponte (US 6,353,825).

 [claim 4]   Rao discloses the system according to claim 3, as explained in the

rejection of claim 3.

        Claim 4 has been amended to recite "wherein: said processor is programmed

with a rule-based system to vary search parameter priority, based on the type of data

requested, wherein said search parameter priority is set to search free text keywords or

a phrase in a specified order."

        Rao discloses the processor searching free text keywords or phrases in a given

order.   (par. 37--through incorporation by reference of "Patient data Mining," US

2003/013087; --Rao discloses that the CPR is generated by systematic search and

extraction of free text par. 11-12) Rao does not expressly disclose a system wherein

the processor is programmed with a rule-based system to vary search parameter

priority, based on the type of data requested, wherein said search parameter priority is

set to search free text keywords or a phrase in a specified order.

Ponte discloses a system wherein: said processor is programmed with a rule-

based system to vary search parameter priority, based on the type of data requested,

wherein said search parameter priority is set to search free text keywords or a phrase in

a specified order. (Figure 6; col. 19, lines 58-col. 20, line 45; process is iterative to

retrieve satisfactory, desired information based upon the search requested by the user;

see also col. 21, lines 5-15, 41-59)

At the time of the applicant's invention, it would have been obvious to one of

ordinary skill in the art to modify the system of Rao with the teaching of Ponte to vary

search parameter priority, based on the type of data requested, wherein said search

parameter priority is set to search free text keywords or a phrase in a specified order.

As suggested by Ponte, one would have been motivated to include this feature to

formulate search queries that effectively return documents of interest, without also

returning many extraneous documents. (col. 7, lines 50-56)

[claim 5]   Rao discloses the system according to claim 4, wherein set to perform

text analysis. (par. 37--through incorporation by reference of "Patient data Mining," US

2003/013087—--Rao discloses that the CPR is generated by systematic search and

extraction of free text par. 11-12; par. 43: search and extraction from a text source may

be carried out by phrase spotting, which requires a list of rules that specify the phrases

of interest)

Response to Arguments

9.   Applicant's arguments filed 7/9/10 have been fully considered but they are not

persuasive.

(A)   Applicant argues the amendment to the limitations.

        Regarding claims 1 and 8, Applicant's arguments amount to a general allegation

that the claims define a patentable invention without specifically pointing out how the

language of the claims patentably distinguishes them from the references. Applicant

has removed the limitation, thereby broadening the scope of the claim. Therefore,

applicant's amendments are not deemed to overcome the prior art of record.

(B)   Applicant's arguments with respect to claims 4-5 have been considered but are

moot in view of the new ground(s) of rejection.

Conclusion

10.   Applicant's amendment necessitated the new ground(s) of rejection presented in

this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP

§ 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37

CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE

MONTHS from the mailing date of this action. In the event a first reply is filed within

TWO MONTHS of the mailing date of this final action and the advisory action is not

mailed until after the end of the THREE-MONTH shortened statutory period, then the

shortened statutory period will expire on the date the advisory action is mailed, and any

extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of

the advisory action. In no event, however, will the statutory period for reply expire later

than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the

examiner should be directed to RACHEL L. PORTER whose telephone number is

(571)272-6775. The examiner can normally be reached on M-F, 10-6:30.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's

supervisor, Robert Morgan can be reached on (571) 272-6773. The fax phone number

for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the

Patent Application Information Retrieval (PAIR) system. Status information for

published applications may be obtained from either Private PAIR or Public PAIR.

Status information for unpublished applications is available through Private PAIR only.

For more information about the PAIR system, see http://pair-direct.uspto.gov. Should

you have questions on access to the Private PAIR system, contact the Electronic

Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a

USPTO Customer Service Representative or access to the automated information

system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/R. L. P./
Examiner, Art Unit 3626

/Robert Morgan/
Supervisory Patent Examiner, Art Unit 3626